REMARKS/ARGUMENTS

This correspondence is filed in response to the non-final Office Action dated October 10, 2006. Applicant notes with appreciation the Examiner's thorough examination of the application as evidenced by the Final Office Action. In response to the Office Action, Applicant has amended the claims to further clarify the present invention. It is respectfully submitted that Claims 1, 11, 12, as amended, are patentable. As such, Applicant respectfully requests reconsideration and allowance of the present claims in light of the following remarks.

Office Action "Response to Arguments" (page 3)

The Office Action, on page 3, provides a section entitled "Response to Arguments", which begins "Applicants arguments filed 25 January 2006...." It is presumed that this was intended to refer to the Applicant's prior remarks filed June 29, 2006. Applicant has addressed the §112 rejection in the section below.

Claim Rejections – 35 U.S.C. §112

Claim 1 was rejected as being indefinite and the Office Action states:

> The claims refer to shipping label. Applicant refers to various labels, including Fig. 6, item 400 (RETURN SHIPPING LABEL and RETURN SERVICE LABEL, as in paragraph 78).

Applicant assumes that in this statement the Examiner is referring to the specification as disclosing various labels, as Applicant believes the prior response did not explicitly referred to Figure 6, item 400. Applicant presumes that the basis of the 112 rejection pertains to the disclosure in the specification of both a "return shipping label 400" as well as a "return service label 400" (see, e.g., paragraph 78), thus leading to ambiguity.

Applicant has amended the specification to consistently refer to the label 400 in Figure 4, as the "return shipping label 400" as well as consistently refer to the phrase "return shipping

label creation date 630." If this does not adequately address the rejection, Applicant requests the Examiner to further elaborate regarding the basis of the rejection.

Claim Rejections – 35 U.S.C. §102

Claim 1 was rejected as being anticipated by U.S. Patent 6,536,659 ("Hauser"). Applicant respectfully submits that Hauser does not anticipate the claim as currently recited.

1) Hauser Does Not Anticipate "initiating a return transaction..."

First, consider the following limitation in claim 1:

> initiating a return transaction upon receipt of a return service request, wherein said return service request contains shipping information, said shipping information comprising an address of said customer and an address of said merchant.

The limitation requires both an "address of said customer and an address of said merchant."

The Office Action identifies the following text in Hauser as anticipating the limitation: Fig. 1, item 12, and 20-24; col. 3 lines 43-63; and col. 3, line 640 col. 4, line 15. Applicant submits that none of these portions disclose both an "address of said customer and an address of said merchant."

For example, Fig. 1 item 12 simply indicates the customer contacts merchant to request return of merchandise. Nothing is disclosed in item 12 of Hauser as to what comprises the address information. In fact, item 12 would appear facially to correspond to the "return service request" of claim 1, not the "return transaction" initiated upon receipt of the return service request. Items 20-24 indicate the customer applies a label and ships the merchandise to "ROI" (presumably, this stands for "Returns Online, Inc.") Item 22 indicates the merchandise is received by ROI and item 24 discloses a label is scanned and the merchandise is sorted. Nothing in the text states "address" information, let alone "address of said customer and an address of said merchant." While it is

admitted that the "label" in item 20 refers to a shipping label, the address is that of ROI, which is neither the merchant or customer.

Further, the text of column 3, lines 43-63 that a customer "contacts a merchant 14 to request authorization to return merchandise to the merchant" and that based on the appropriate reasons, authorization will be granted. Again, nothing is disclosed about initiating a return transaction wherein the shipping information "comprising an address of said customer and an address of said merchant." Finally, column 3, lines 65 – column 4, line 15 again does not disclose this limitation. It does state that "return data" is transmitted to Returns Online, Inc. However, it states that "[t]he data transmitted to Returns Online, Inc. by a merchant who has authorized the return of merchandise will *identify the customer* who requested the return and the merchant authorizing the return, will indicate the address and other contact information for the customer, and will include a description of the merchandise that identifies all items that should be included. (Col. 4, lines 9-14, emphasis added.) Again, there is no disclosure of shipping information that comprises "an address of said customer *and an address of said merchant*."

This distinction is not trivial. Hauser operates a central returns facility, so that all returns from any customer are sent to "Returns OnLine, Inc." Consequently, each shipping return label always bears the same consignee (e.g., "ship to") address. This means that there is no procedure (nor any need) for including the address of the merchant when providing the return label. Further, because the merchandise in Hauser is directed to a separate and common returns facility, the returns facility has to be provided information about which merchant the merchandise pertains to. Consequently, the entire returns procedures is predicated on a different model than the present invention, and the distinction is manifested by Hauser disclosing a single return address on the electronic shipping label, as opposed to the return address of each respective merchant.

Because anticipation require disclosure of each and every limitation, it is not sufficient that the prior art disclose some, but not all of the limitations of the claim. Further, there is no basis for inherently presuming that the "address of said merchant" is

also provided. Thus, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

2) Hauser Does Not Anticipate "Assigning a package tracking identifier...."

Next, consider the limitation reciting (with amendment):

> assigning a package tracking identifier by a carrier server to said return transaction, wherein said package tracking identifier is readable by a carrier shipment tracking system associated with a carrier for tracking shipment of said good to be returned.

Applicant has amended claim 1 to better state the invention, namely that the package tracking identifier is assigned by "a carrier server" and that the server is associated with "a carrier" (which provides the proper antecedent basis for "the carrier" subsequently recited in the next limitation). This limitation is alleged to be anticipated by Hauser in column 2, lines 49-67; column 3, lines 65-column 4, lines 15, see also references to Return Merchandise Authorization number, as in column 3, lines 43-64, and other references to tracking as in column 3, lines 65-column 4, line 14.

Applicant submits that again, the Hauser reference does not disclose the recited limitation. First, consider column 2, lines 49-67. This discloses the recipient (which is ROI) reports the condition and disposition of the merchandise to the merchant, including whether the merchandise meets a condition specified by the merchant. A report regarding the status and/or condition of the merchandise is optionally provided to the merchant at any desired point in processing of the returned merchandise by ROI. The report shows the condition of the merchandise that has been returned.

This refers to the *central return facility* inspecting the merchandise and reporting its condition, *not the carrier handing the delivery.* Once ROI receives the returned merchandise, the carrier has already delivered the goods. ROI has opened the package

and inspected the contents. The carrier would not know the condition of the merchandise, much less the "condition specified by the merchant."

Applicant notes that the limitation reciting a "package tracking identifier" is assigned where it is identified as "readable by a **carrier** shipment tracking system". In other words, it is immaterial to what extent the central return facility is capable of processing bar codes on return labels, because the limitation pertains the tracking identifier being readable by the carriers' shipment tracking system. There is no disclosure in the cited portion of Hauser of a "carrier shipment tracking system," much less an identifier being readable by it. While Hauser has bar codes, this not for tracking the shipping, but identifying the originating merchant authorizing the return (col. 4, lines 18-21.)

Next, column 3, line 65 – column 4, lines 15 is also alleged to disclose the recited limitation. This initially states who may ship the merchandise, which is not relevant to the identified limitation. The text does then state that "return data" is transmitted to Returns Online, Inc, and

> "[t]he data transmitted to Returns Online, Inc. by a merchant who has authorized the return of merchandise will identify the customer who requested the return and the merchant authorizing the return, will indicate the address and other contact information for the customer, and will include a description of the merchandise that identifies all items that should be included. (Col. 4, lines 9-14)

Again, there is no disclosure of a "package tracking identifier" at all, much less one that is "readable by a carrier shipment tracking system."

Next, the Office Action references column 3, lines 43-64. This states how a customer obtains authorization to return merchandise, the reasons why it may be returned, and where it is returned to. Indicating a reason why a package is being returned is not the same as a package tracking identifier. Again, there is no text disclosing the limitations of "assigning a package tracking identifier" much less one that is "readable by a carrier shipment tracking system."

Finally, the Office Action references column 3, lines 65- column 4, lines 14. This was identified before, and responded thereto by the Applicant.

In summary, nothing in the cited sections of Hauser can be read as disclosing a "package tracking identifier" wherein it is "readable by a carrier shipment tracking system." Further, the tracking in the claim is not identification of the good as it is being processed by the central returns facility, the tracking is for "tracking shipment" of the good which pertains to a carrier. In Hauser, the "tracking" of the good refers to the condition and handling of the good ascertained by Returns OnLine, Inc, that occurs after the carrier has delivered it to the central return facility. Hauser discloses a separate identifier use by the consignee (Returns OnLine, Inc.) that is used to track merchandise and their condition.

Without the prior art reference disclosing each and every limitation of a claim, there cannot be any anticipation. See, e.g., *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

3) Hauser Does Not Anticipate "Generating said shipping label..."

Applicant has amended this limitation to recite "generating said shipping label in electronic form by said carrier server..." to better state the invention, as opposed to distinguishing the prior art. The electronic form of the label, not a physical printed version of the label, is created by the carrier's server.

The complete limitation as amended recites:

> generating said shipping label in electronic form by said carrier server based at least in part on said shipping information, said shipping label being acceptable by said carrier to deliver said good to said merchant according to said return transaction and including said package tracking identifier for tracking shipment of said good during return delivery to said merchant;

The Office Action alleges that column 3, lines 43-64 of Hauser anticipates the above limitation. Applicant is at a loss to understand where the limitations are disclosed in the cited text. The cited text indicates how a customer obtains authorization to return

merchandise, reasons why the merchandise may be returned, and where it is returned to. Again, there is no text disclosing the limitations of "generating said shipping label in electronic form" much less one that is qualified by the subsequent limitations. While Applicant notes that column 4, lines 18-20 discloses that the central returns facility ("Returns OnLine, Inc.") will generate a label, there is no disclosure of the label including "said package tracking identifier." If there are other portions of Hauser disclosing "tracking identifiers," Applicant is not aware of such text.

Applicant further directs attention to column 4, lines 16-20. This states that "[u]pon receiving the data from a merchant who has authorized the return of the merchandise, Returns OnLine, Inc. (not the carrier's server), will generate a return authorization shipping label as indicated in block 18." The "data" that is transmitted to Returns Online, Inc, is detailed in the prior sentence (column 4, lines 10-15). Hauser states the data transmitted will "identify the customer who requested the return and the merchant authorizing the return."

Applicant submits Hauser does not disclose the claimed limitation. Without the prior art reference disclosing the limitation, there cannot be any anticipation. See, e.g., *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim 11

Claim 11 has been amended to better state the invention and now recites:

> storing an electronic image of said shipping label, and
>
> sending to said customer a label delivery link through which said customer obtain access to said electronic image on the carrier server.

Applicant submits that Hauser does not disclose the limitations of claim 11, and is patentable not only for reciting limitations in claim 11 that are distinct, but also patentable for incorporating limitations from claim 1 which are distinct.

Claim 12

Applicant submits that claim 12 is patentable for incorporating limitations from claim 11 and claim 1 which are distinct from Hauser.

Request for Further Information

In the Office Action, an issue of public use or sale was raised, and a request for additional information was requested. Specifically, materials prior to March 14, 2000 regarding "UPS Returns on the Web" product were requested, including:

> "Versions prior to 1.0.6 dated 2/13/01
> Revisions of XML OnLine Tools, Returns on the Web, IMT 300 Architecture, Versions prior to version 000927.01, copyright 2000."

Applicant presumes that the above are references to documents submitted as an appendix to the provisional. Applicant is providing a declaration as evidence that there are no versions of these documents. Applicant is also providing an "unredacted" version of the documents, which disclose various dates and revision history tables, in order to show why there are no earlier versions of the documents. Although the unredacted versions of the documents are not prior to March 14, 2000, Applicant submits these in an effort to fulfill the spirit of the request by the examiner in order to show that that there was not prior use of sale of the invention prior to March 14, 2000.

Applicant has provided a copy of the unredacted document labeled as "Exhibit A" on the first page, and entitled "UPS Returns on the Web, Deployment and Implementation Procedures", labeled as "Draft" and exhibiting a date of "September 27, 2000" above the label "Version 000927.01." The date was initially redacted. Further, at the bottom of each page, a date of "©2000" is unredacted. The document does not contain a revision history table therein.

Applicant has provided an unredacted copy of the document, labeled as "Exhibit B", and entitled "XML OnLine Tools, Returns on the Web, IMT 300, Architecture." This document bears the label of "Document 1.0, version 1.0.6, and the unredacted date reads "Tuesday, February 13, 2001."

Applicant notes that a footer on each page bears the date of 2/13/01 and that a revision datable on page 4, has the dates unredacted and indicates that revision 1.0.0 was first dated 1/3/2001, and labeled as "Initial document."

Applicant also draws the Examiner's attention to a series of tables in the document, spanning from page 25 through 32, which bear time-based charts estimating service-related volumes. In each case, the estimates start around February or March of 2001. In no case are the volumes starting earlier than 2001.

Applicant has provided an unredacted copy of the document, labeled as "Exhibit C", and entitled "Developer's Guide, UPS OnLine Tools, Return on the Web." In the upper right corner, the date has been unredacted and states "Documentation Date: March 15, 2001." Also, the footer evidences a copyright 2001 date.

Applicant has provided an unredacted copy of the document, labeled as "Exhibit D", and entitled "XML OnLine Tools I_1 Interface Specification." A date has been unredacted, and states "Monday, February 19, 2001." A document history table on page 2 is unredacted, and indicates that Revision 1.0.0 was authored by one of the inventors on "12/4/2000" and labeled as "Initial document."

Applicant notes that it appears a duplicative copy of one of the manuals was appended in the provisional application (e.g., XML OnLine Tools Retruns On the Web, IMT 300 Architecture). However, as it appears to a duplicate, nothing further is warrants discussion and a duplicate copy is not provided herein.

Applicant has also provided a Declaration by a co-inventor stating that either that no versions of these documents were created prior to March 14, 2000 or that the co-inventor is unaware of the existence of such documents.

Finally, Applicant is submitting in an IDS a copy of a non-patent reference, which is an article from the Wall Street Journal dated September 21, 2000, and entitled "UPS Launches Package – Return Service for Web Purchases That Tracks Progress."

The documents provided should resolve any issue whether the invention was offered for sale, or in public use, prior to March 14, 2000. Applicant submits that this is a complete and responsive reply to the request made by the Examiner in the Office Action.

SUMMARY/CONCLUSION

Applicant respectfully submits that the above amendments recite limitations that are not disclosed or rendered obvious by the cited art of record. Applicant respectfully requests that the notice of rejection be withdrawn and that the claims be placed in a condition of allowance. Applicant further submits that a full and responsive reply to the request for further information has been made, and that there is no issues regarding prior use or sale of the invention prior to March 14, 2000.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper.

However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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